

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application Of:)
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 Theodore J. BOWERS *et al.*) Group Art Unit: 2137
)
 Application Number: 09/902,612) Examiner: Kevin R. SCHUBERT
)
 Filed: July 12, 2001) Confirmation No.: 1294

For: SYSTEM AND METHOD FOR PROVIDING
DISCRIMINATED CONTENT TO NETWORK USERS

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Commissioner for Patents
P.O. Box 1450
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REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

Sir

Pursuant to the Pre-Appeal Brief Conference Pilot Program announced in the Official Gazette, Applicants hereby request a pre-appeal brief conference in the above-referenced case. No amendments are being filed with this request. Additionally, this request is being filed with a Notice of Appeal.

This application is appropriate for a pre-appeal brief conference. A brief history of this application and why applicants believe that an appeal will succeed are set forth below.

This application was filed over five years ago on July 12, 2001. On October 6, 2004, an initial action was issued rejecting claims 1-54 based on alleged anticipation by U.S. 5,991,740 to Messer ("Messer") under section 102. On December 22, 2004, Applicants timely filed a responsive amendment to the Office Action and argued against the rejection. On April 21, 2005, claims 1-54 were finally rejected using the same Messer reference. On July 8, 2005, Applicants timely filed a Request for Continued Examination (RCE) which included amendments to clarify and distinguish the claimed invention from Messer. On October 18, 2005, the Office found Applicants amendments/arguments persuasive and issued a new rejection based on the combination of U.S. Patent No. 6,754,833 to Black et al. ("Black") in view of Network Computing's "The New Face of Single Sign-On" to Philip Carden ("Carden") under section 103. On January 18, 2006, Applicants filed a responsive amendment to distinguish the claimed

invention from Black and Carden. On April 26, 2006, a final Office Action was issued rejecting claims 1-54 again with the same references; however, the Office Action indicated allowable subject matter in claims 12 and 39 and advised Applicants to rewrite the claims in independent form. Accordingly, on May 31, 2006, independent claims 1 and 28 were amended to include the allowable subject matter of claims 12 and 13 as indicated by the Examiner. Claims 11-27 and 38-54 were cancelled and new dependent claims 55-58 were added to further clarify important distinctions of the present invention. Rather than withdrawing the rejections and allowing the claims, a new non-final Office Action was issued on June 14, 2006, maintaining the same rejections with Black and Carden under section 103, *including, without any substantive explanation, the previously indicated allowable subject matter*. Despite several additional attempts to clarify important distinctions of the present invention, a final Office Action dated September 28, 2006 and an Advisory Action dated January 10, 2007 has been entered against claims 1-10, 28-37, and 55-58 on the combination of Black and Carden under section 103.

Applicants respectfully submit that the proposed combination of Black and Carden fails to teach or suggest all of the claim limitations, and therefore no *prima facie* case of obviousness exists in this case. Specifically, with respect to independent claims 1 and 28, the proposed combination fails to teach:

- “a single login session,”
- “said host system comprising a financial service provider system with which a user of the host system has one or more financial accounts,”
- “identifying said user’s financial account data,”
- “providing discriminated partner system resources to said user...selected based at least upon...said user’s financial account data,” and
- “wherein providing discriminated partner system resources comprises creating discriminated partner system resources identified with said host system comprising: identifying graphical information used by said host system, replicating said graphical information, classifying said host system, identifying non-conflicting additional partner system resources that do not conflict with said host system’s classification, and incorporating said replicated graphical information and said non-conflicting additional

partner system resources into a standard partner system resource to create a discriminated partner system resource.”

Black and Carden fail to recite a value-added banking experience on the Internet that examines the *user's financial information* to present *various discriminated resources* to the user through *a single login session*. In fact, because the Internet Provider (the alleged “partner system”) of Black simply provides a tailored web page for the Wireless Carrier (the alleged “host system”), there is *no reason* to discriminate the partner resources relative to the services offered by the host resources, as these services are not in competition, and are intended to be mutually beneficial. Furthermore, the cited art simply describes a business model in which the Internet Partner sets up a branded web site for a Wireless Carrier. As a result, the method and system of providing “discriminated partner system resources to a user of a host system during a single login session” where the host system comprises “a financial service provider system with which a user of the host system has one or more financial accounts,” as recited in the claim 1 and 28, as well as the subsequent steps of these claims, are **completely missing from Black and Carden**. See Office Action at ¶ 14.¹ As such, this allegation, without being mentioned in the cited art, cannot support a *prima facie* case of obviousness.

Furthermore, the Examiner acknowledges that Black fails to disclose the feature and functionality of “a single login session”, as set for in claims 1 and 28. The Examiner relies on Carden to make up for this deficiency in Black, but Carden, as acknowledged by the Examiner, merely teaches the “idea.” See Office Action at p. 4. Carden describes, in only very general terms, the use of Single Sign-On technology to access information on any of several systems. Thus, Carden fails to make up for the deficiencies of Black to teach or suggest “a single login session” for “providing discriminated partner system resources to a user of host system,” as required by the claimed invention. At best, Black and Carden disclose a non-discriminatory inter-page service, which is clearly distinguishable from the present invention for the reasons set forth in the Background of the Invention. See Specification, p. 1, line 8 - p. 4, line 22.

¹ Although the Examiner cites to Black on numerous occasions, alleging that the features and functionalities are disclosed in the reference, a detailed examination reveals that these citations are, at best, merely descriptions of the general concept of providing branded content to users and say nothing relevant to the features recited in the claims.

Even assuming, for the sake of argument, that Black and Carden teach all of the limitations set forth above, Applicants submit that the **PTO does not present a proper motivation to combine the references** to achieve the claimed system and method, and thus has failed to set forth a *prima facie* case of obviousness. In particular, the allegation that one of ordinary skill in the art would have modified Black by the teaching of Carden to make “the system easier to use and may reduce the number of passwords a user must remember” is not proper motivation to support the purported combination of references. *See* Office Action at p. 4.

First, Applicants respectfully submit that the Examiner improperly *assumes* the combination recited in the claim would be desired. For example, the Examiner asserts that the combination “may reduce the number of passwords” (emphasis added). *See* Office Action at p. 4. The PTO has the burden to establish that the prior art taken as a whole suggests the desire or advantage. Here, the Examiner himself simply assumes from one line of Carden (not the reference as whole) that it would have been obvious to one of ordinary skill in the art to incorporate a single login session to Black’s method and system. Thus, without explaining *why* the art *as a whole* would suggest to combine such a feature specifically with Black’s system for distributing revenue, the assertion that a secondary reference “may” reduce the number of passwords simply does not constitute specific motivation or suggestion for the combination. The inquiry is not whether, in *post hoc* fashion one reference may benefit from another – rather, the inquiry is whether the prior art provides specific motivation to select the second reference and combine it with the first in the specific manner urged by the Examiner. Thus, the Examiner’s assumption is clearly improper.

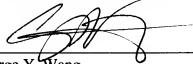
Second, Applicants submit that the Examiner’s assertion of motivation is lacking in *evidence* because the Examiner improperly relies on his own hindsight conjecture that the feature of a single login session “makes the system *easier to use*” (emphasis added). *See* Office Action at p. 4. The Examiner’s statement that Black would be made “easier to use” from Carden is wholly unsupported. For example, Carden says nothing about making *Black’s system* “easier to use.” *See* Carden at p. 6; Office Action at p. 10. Neither Black or Carden disclose anything to indicate that Black’s system would benefit from the teachings of Carden, specifically the use of a single login session. In fact, Black is concerned with a business model and method for generating and distributing the Telecom and Internet revenue produced when a subscriber of a

wireless carrier accesses a group of specialized services and applications through a web-site, whereas Carden is primarily concerned with minimizing expenditures associated with “password-related helpdesk calls” as an effort to boost security. *See* Carden at p. 6. In fact, password reduction and user ID are not even the “primary function of an SSO solution.” *See* Carden at p. 6. Therefore, the person of ordinary skill would not likely be motivated to combine teachings from these disparate references to arrive at Applicants’ invention. As a result, Applicants respectfully submit that the combination of Black and Carden would not have been suggested to one of ordinary skill in the art at the time of the invention and that the Examiner’s conclusion is clearly based on **improper hindsight** reasoning. Thus, the Examiner has failed to set forth a *prima facie* case of obviousness.

Therefore, an appeal on that basis will certainly succeed, but the time and expense in preparing an appeal brief on that issue should not be borne by JPMorgan Chase Bank when the grounds is so clearly improper.

Respectfully submitted,

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